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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/642,934

08/18/2003

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29757/P-835

4848

4743 7590 02/22/2007
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EXAMINER

LEE, BENJAMIN WILLIAM

ART UNIT

PAPER NUMBER

3714

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

02/22/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/642,934

Applicant(s)

NGUYEN ET AL.

Examiner

Benjamin W. Lee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date See Continuation Sheet.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :1-5-2004; 4-23-2004; 10-14-2004; 1-28-2005; 5-19-2005; 10-10-2006; 11-8-2006.

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-34 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Re claim 1: The claim is directed toward a method, which is one of the four statutory categories of invention (e.g. process, machine, manufacture, and composition of matter).

However, the process disclosed in the claim includes the judicial exception of an abstract idea (a gaming method). No physical transformation is present to establish a practical application of the abstract idea. Furthermore, the process disclosed in the claim does not contain a useful, concrete, and tangible result. "Generating data indicative of a value payout to be awarded to the winning player" is useful and concrete, but not tangible. Therefore, the claim is directed toward non-statutory subject matter.

Re claims 2-13: The claims are dependent upon claim 1 and do not disclose any further method steps that result in useful, concrete, and tangible results. Therefore, the claims are directed toward non-statutory subject matter.

Re claims 14 and 25: The claims are directed toward a machine or manufacture, which fall under the four statutory categories of invention (e.g. process, machine, manufacture, and composition of matter). However, the invention disclosed in the claims implement methods similar to the method disclosed in claim 1. Therefore, claims 14 and 25 are also directed toward non-statutory subject matter because the disclosed inventions do not contain useful, concrete, and tangible results.

Re claims 15-24 and 26-34: The claims are dependent upon claims 14 and 25, respectively, and do not disclose any further method steps that result in useful, concrete, and tangible results. Therefore, the claims are directed toward non-statutory subject matter.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-4, 7-9, and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Kelly et al. (US 2002/0010025 A1):

Re claim 1: Kelly et al. discloses a gaming method comprising receiving a fee from a player to play in a tournament (see Fig. 3; ¶ [0040], lines 9-11), receiving data/login information

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indicative of a gaming unit on which the player has chosen to play in the tournament (see Fig. 3; ¶ [0040], lines 9-11; ¶ [0088]), loading gaming software to the chosen gaming unit after the player has chosen the gaming unit, wherein the gaming software is to configure the chosen gaming unit for playing in the tournament (see Fig. 9; ¶ [0092]), enabling the chosen gaming unit for playing in the tournament (see Fig. 9; ¶ [0093]), determining a winning player of the tournament, if any (see ¶ [0119], ¶ [0120]), and if the winning player of the tournament is determined, generating data indicative of a value payout to be awarded (see ¶ [0119], ¶ [0120]).

Re claim 2: The teachings of Kelly et al. as applied to claim 1 have been discussed above. Kelly et al. further discloses determining whether the chosen gaming unit is already configured for playing in the tournament (see Fig. 9; ¶ [0092]) and loading gaming software to the chosen gaming unit only if the gaming unit is not already configured for playing in the tournament (see Fig. 9; ¶ [0092]).

Re claim 3: The teachings of Kelly et al. as applied to claim 1 have been discussed above. Kelly et al. further discloses transmitting the gaming software to the gaming unit via a network (see Figs. 1 and 4; ¶ [0092]).

Re claim 4: The teachings of Kelly et al. as applied to claim 1 have been discussed above. Kelly et al. further discloses loading the gaming software from a diskette, CD-ROM, or portable memory device (see ¶ [0036]).

Re claim 7: The teachings of Kelly et al. as applied to claim 1 have been discussed above. Kelly et al. further discloses the gaming software comprises an executable file (see ¶ [0092]).

Re claim 8: The teachings of Kelly et al. as applied to claim 1 have been discussed above. Kelly et al. further discloses the gaming software is a configuration file (see ¶ [0050]; ¶ [0051]).

Re claim 9: The teachings of Kelly et al. as applied to claims 1, 7, and 8 have been discussed above. Executable files and configuration files may be considered data files.

Re claim 13: The teachings of Kelly et al. as applied to claim 1 have been discussed above. Kelly et al. further discloses generating data indicative of a plurality of respective value payouts to be awarded to the plurality of winning players, wherein the plurality of respective value payouts comprises a plurality of shares of a jackpot (see ¶ [0119]; ¶ [0120]).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out

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the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 14, 15, 18-20, 24, 25, 28-30, and 34 rejected under 35 U.S.C. 103(a) as being unpatentable over Kelly et al.

Re claims 14 and 25: The teachings of Kelly et al. as applied to claim 1 have been discussed above. Kelly et al. further discloses a tournament server/prize database server 104/servers 112 operable to perform the gaming method recited in claim 1 and comprising a network interface operatively coupled to a network 100 (see Fig. 1; ¶ [0028]).

However, Kelly et al. fails to disclose or fairly suggest the tournament server comprises a controller operatively coupled to the network interface, the controller comprising a processor and a memory operatively coupled to the processor.

It was well known in the art at the time the invention was made to use processors and memory in servers.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a processor and memory in the tournament server in order to allow the server to communicate with the gaming unit.

Re claim 18-20: The teachings of Kelly et al. as applied to claims 7-9 and 14 have been discussed above.

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Re claim 24: The teachings of Kelly et al. as applied to claims 13 and 14 have been discussed above.

Re claims 28-30: The teachings of Kelly et al. as applied to claims 7-9 and 25 have been discussed above.

Re claim 34: The teachings of Kelly et al. as applied to claims 25 and 13 have been discussed above.

8. Claims 5, 16, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kelly et al. in view of Okamoto (US 5,489,103).

Re claim 5: The teachings of Kelly et al. as applied to claim 1 have been discussed above.

However, Kelly et al. fails to disclose or fairly suggest confirming that the gaming software was loaded to the gaming unit successfully.

Okamoto teaches a method for transferring game or karaoke data from a host facility to a plurality of terminals. At step S1150 the host facility is notified that the transmission was completed following the completion of a data transfer (see Fig. 6; col. 6, lines 32-42).

Therefore, in view of Okamoto, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add the step of confirming a successful software load to the system of Kelly et al. in order to provide a more reliable and easier to troubleshoot data transfer.

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Re claim 24: The teachings of Kelly et al. as applied to claims 13 and 14 have been discussed above.

Re claims 28-30: The teachings of Kelly et al. as applied to claims 7-9 and 25 have been discussed above.

Re claim 34: The teachings of Kelly et al. as applied to claims 25 and 13 have been discussed above.

8. Claims 5, 16, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kelly et al. in view of Okamoto (US 5,489,103).

Re claim 5: The teachings of Kelly et al. as applied to claim 1 have been discussed above.

However, Kelly et al. fails to disclose or fairly suggest confirming that the gaming software was loaded to the gaming unit successfully.

Okamoto teaches a method for transferring game or karaoke data from a host facility to a plurality of terminals. At step S1150 the host facility is notified that the transmission was completed following the completion of a data transfer (see Fig. 6; col. 6, lines 32-42).

Therefore, in view of Okamoto, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add the step of confirming a successful software load to the system of Kelly et al. in order to provide a more reliable and easier to troubleshoot data transfer.

Re claims 16 and 26: The teachings of Kelly et al. as applied to claims 14 and 25 have been discussed above. The teachings of Kelly et al. as modified by Okamoto as applied to claim 5 have been discussed above.

9. Claims 6, 17, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kelly et al. in view of Schneier et al. (US 5,768,382).

Re claim 6: The teachings of Kelly et al. as applied to claim 1 have been discussed above.

However, Kelly et al. fails to disclose or fairly suggest authenticating the gaming software after loading the gaming software to the gaming unit.

Schneier et al. teaches authenticating game software by generating a hash value of the game software (see Figs. 6A and 6B; col. 18, line 31 - col. 19, line 19).

Therefore, in view of Schneier et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to add the step of authenticating the game software after loading in order to provide a more reliable and secure system.

Re claims 17 and 27: The teachings of Kelly et al. as applied to claims 14 and 25 have been discussed above. The teachings of Kelly et al. as modified by Schneier et al. as applied to claim 6 have been discussed above.

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10. Claims 10, 21, and 31 rejected under 35 U.S.C. 103(a) as being unpatentable over Kelly et al. in view of Morrow et al. (US 2003/0064771).

Re claim 10: The teachings of Kelly et al. as applied to claim 1 have been discussed above.

However, Kelly et al. fails to disclose or fairly suggest the gaming software comprises a pay table.

Morrow et al. teaches a reconfigurable gaming machine wherein the game on the gaming machine may be changed by transferring new game software via a network. Morrow et al. discloses that new pay tables may be downloaded (see ¶ [0012]).

Therefore, in view of Morrow et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to add the step of transferring a new pay table along with corresponding game software in order to provide a greater variety of game to players.

Re claims 21 and 31: The teachings of Kelly et al. as applied to claims 14 and 25 have been discussed above. The teachings of Kelly et al. as modified by Morrow et al. as applied to claim 10 have been discussed above.

11. Claims 11, 12, 22, 23, 32, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kelly et al. in view of Halliburton et al. (US 2002/0052229 A1).

Re claims 11 and 12: The teachings of Kelly et al. as applied to claim 1 have been discussed above.

However, Kelly et al. fails to disclose or fairly suggest randomly of pseudo-randomly generating a plurality of seeds for a random number generator to be implemented by the gaming unit.

Halliburton et al. teaches a solitaire game played over the Internet that uses a server/client architecture. The sequence of cards for each player is determined by using a randomly generated seed to locally generate a random sequence of cards (see ¶ [0045], lines 19-23).

Therefore, in view of Halliburton et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the server randomly generate a plurality of seeds and send them to game playing clients for generating random outcomes in order to provide more effective random number generation since the seed is generated independently of the gaming unit.

Re claims 22, 23, 32, and 33: The teachings of Kelly et al. as applied to claims 14 and 25 have been discussed above. The teachings of Kelly et al. as modified by Halliburton et al. as applied to claims 11 and 12 have been discussed above.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Sham discloses a system and method of generating revenue through tournament play.

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13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin W. Lee whose telephone number is 571-270-1346. The examiner can normally be reached on Mon - Thurs (8:30AM-6PM), or Alt. Fri (8:30AM-5PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on 571-272-6788. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

bwl/
Benjamin W. Lee
February 16, 2007


KIM NGUYEN
PRIMARY EXAMINER